

REMARKS

This is in response to the Office Action mailed on September 14, 2004, and the references cited therewith. Claims 1-7, 9-20, 24-27 and 30 are amended. Claims 1-7, 9-30 are now pending in this application. Amendments to claims are not related to patentability (e.g., amendments to remove the “steps” language, and to introduce consistent preambles).

Applicant does not admit that the cited references are prior art and reserves the right to “swear behind” each of the cited references as provided under 37 C.F.R. 1.131.

§102 Rejection of the Claims

Claims 1-3, 5-7, 9-12, 20-25 and 28-29 were rejected under 35 USC § 102(e) as allegedly being anticipated by Fleming (U.S. 5,953,710). Applicant respectfully traverses the rejections because Fleming does not anticipate the claimed invention, as set forth in claims 1-3, 5-7, 9-12, 20-25 and 28-29. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (*en banc*), *cert. denied*, 500 U.S. 904 (1991).

Among the differences, claim 1 recites “establishing a group fund corresponding to at least one shared expense of the group.” (emphasis added). The Office Action indicated that this limitation is disclosed in Fleming at column 10, lines 10-47; column 12, lines 55-65 and column 16, lines 15-30. Fleming relates to a method for allocating, by a parent, available credit on credit cards for the parent and a child. Fleming relates to the redistribution of a credit limit among parents and children for which the parent is responsible. In other words, Fleming relates to

[a] method and system [that] allow: a parent to make changes in the child’s available credit without changing the total combined credit limit and available credit for the child’s and parent’s credit card accounts and without requiring bank approval Fleming at column 3, lines 14-19.

Fleming does not disclose a group fund for a shared expense. Specifically, Fleming does not disclose a sharing of an expense. In other words, the child is not sharing an expense with the

parent. Rather, the parent is responsible for expenses charged by the child but not vice versa.

See, for example, Fleming at column 12, lines 31-35 and lines 45-46.

Also, among the differences, claim 1 recites “allocating said group expense specified by said transaction details among group members of said group.” The Office Action indicated that this limitation is disclosed in Fleming at column 10, lines 43-47. As noted by the Office Action, this citation in Fleming relates to “updating the available credit limit [for the parent and the child].” Office Action at page 3. This citation relates to the redistribution of a credit limit between parent and child. Such citation does not disclose the allocation of a group expense among group members.

Accordingly, because Fleming does not teach each element of claim 1, Applicant respectfully submits that the rejection of claim 1 has been overcome and that this claim is in condition for allowance. Because claims 2-3, 5-7, 9-12, 20-25 and 28-29 depend from and further define claim 1, Applicant respectfully submits that the rejection of claims 2-3, 5-7, 9-12, 20-25 and 28-29 have been overcome and that these claims are in condition for allowance. Moreover, these claims also include limitations that allow the claims to be patentable over Fleming.

For example, among the differences, claim 20 recites “wherein said receiving includes acquiring an authorization of payment of the group expense from said group members.” The Office Action indicated that this limitation was disclosed in Fleming at column 12, lines 25-55. This citation in Fleming relates to the payment either by the parent or child and how such payment affects the credits limits of the parent or child. This citation does not disclose authorization by the group members of a group expense. Accordingly, because Fleming does not teach each element of claim 20, Applicant respectfully submits that the rejection of claim 20 has been overcome and that this claim is in condition for allowance.

With regard to claim 25, in addition to the remarks regarding claim 1 from which claim 25 depends, Applicant respectfully submits the following remarks. Among the differences, claim 25 recites “determining that a group member has made an early payment and paying said group member interest on the amount of the payment until said payment is due.” The Office Action indicated that this limitation in Fleming at column 12, lines 25-42. As described above, this citation in Fleming relates to the payment either by the parent or child and how such

payment affects the credits limits of the parent or child. This citation does not disclose paying one of the group members based on early payment. Accordingly, because Fleming does not teach each element of claim 25, Applicant respectfully submits that the rejection of claim 25 has been overcome and that this claim is in condition for allowance.

§103 Rejection of the Claims

Claims 4, 13-19, 26-27 and 30 were rejected under 35 USC § 103(a) as being unpatentable over Wallman (U.S. 6,338,047). The details of this rejection do not include references to Wallman (only Fleming). Applicant assumes that this rejection under 35 USC § 103(a) is based on Fleming.

Because claims 4, 13-19, 26-27 and 30 depend from and further define claim 1, Applicant respectfully submits that claims 4, 13-19, 26-27 and 30 are patentable over Fleming. Such claims are also patentable for the reasons set forth below.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all

the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

The references must teach or suggest all the claim elements. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness because Fleming fails to teach or suggest all of the elements of Applicant's claimed invention.

Claim 4

Among the differences, claim 4 recites "rounding up an original expense value to a new expense value having a predefined number of decimal places; and distributing a difference between said new expense value and said original expense value to a third party." The Office Action indicated that this limitation was not disclosed by Fleming but that "it would have been obvious to modify Fleming's to include the feature . . ." Office Action at page 7.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claim are found in Fleming. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to *M.P.E.P.* § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 4 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 4.

Claims 13-15

With regard to claims 13-15, the Office Action indicated that

Fleming does not directly teach settling step comprises the step of accepting electronic deposits into group fund by collecting a credit card or an electronic check deposit electronic deposit into group fund. However, electronic funds using credit card or electronic check is well known in the art. . . . Therefore, it would have been obvious to modify Fleming's to include the feature above for the purpose of time consuming because collecting funds using credit card or electronic check is faster than a paper check or money order sent by mail.

Office Action at page 7.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in Fleming. Since all the elements of the claims are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claims 13-15 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claims 13-15.

Claim 16

Among the differences, claim 16 recites "wherein said settling comprises transferring funds from said group fund to a financial institution account of a group member." The Office

Action indicated that Fleming does not teach this limitation but that “it would have been obvious to modify Fleming’s to include the feature . . . for the purpose of timing consuming.” Office Action at page 7.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in Fleming. Since all the elements of the claims are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 16 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 16.

Claim 17

Among the differences, claim 17 recites “emailing group members to notify them of their outstanding balance in said group fund.” The Office Action indicated that Fleming does not disclose this limitation but that “it would have been obvious to modify Fleming’s to include the feature . . . for the purpose of providing more convenient to the member to keep track of the account information.”

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in Fleming. Since all the elements of the claims are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 17 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of

obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 17.

Claims 18-19

Among the differences, claim 18 recites “wherein said receiving includes receiving said transaction details from a form appearing in a web page.” Claim 19 recites “wherein said allocating further includes generating a web page interface with a form reporting allocated expenses.” The Office Action indicated that Fleming does not disclose these limitations but that “it would have been obvious to modify Fleming’s to include the feature . . . for the purpose of providing more convenient to the member to keep track of the account information.”

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claims are found in Fleming. Since all the elements of the claims are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claims 18-19 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claims 18-19.

Claim 26

With regard to claim 26, among the differences, claim 26 recites “determining that one group member is delinquent in paying his share of a group expense and removing said one group member from said group.” The Office Action indicated that Fleming did not teach this limitation but that “Fleming does teach parent can request to disable the child’s credit card (column 11, lines 27-50). The Office Action then indicated that “it would have been obvious in Fleming’s that parent can request to disable the child’s credit card when the child fails to make payment in the child’s credit card account, thus it encourages the child to make payment in order to continue

using the credit card for purchase, other the credit card will be disable.” Office Action at page 8. Fleming disclose that “a parent [is] to make a single payment for their account and their children. Fleming at column 3, lines 55-56.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claim are found in Fleming. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 26 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 26.

Claim 27

Among the differences, claim 27 recites “determining whether one member of the group would like to ask other members of said group to settle up, and if so to contact said other members via the electronic network to settle up.” The Office Action indicated that “it would have been obvious to modify Fleming’s to include the feature above for the purpose of providing more convenient to the members to communicating each others regarding to settle up group funds.” Office Action at page 9.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claim are found in Fleming. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 27 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 27.

Claim 30

With regard to claim 30, among the differences, claim 30 recites “determining when any of the group members owes more than a predetermined amount of money, and subsequently reminding said any of the group members via e-mail to settle up.” The Office Action indicated that “it would have been obvious to modify Fleming’s to include the feature above for the purpose of providing more convenient to the member to keep track of the account information.” Office Action at page 9.

Applicant respectfully traverses the single reference obviousness rejection under 35 U.S.C. § 103 since not all of the recited elements of the claim are found in Fleming. Since all the elements of the claim are not found in the reference, Applicant assumes that the Examiner is taking Official Notice of the missing elements. Applicant respectfully objects to the taking of Official Notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Since all the limitations of claim 30 are not found in Fleming, the rejection under 35 U.S.C. 103(a) now fails because the Office Action did not make out a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration of this rejection and allowance of claim 30.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

HUGO OLLIPHANT

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 371-2103

Date

10-28-04

By

Gregg A Peacock

Reg. No. 45,001

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 28th day of October, 2004.

Name

Amy Moriarty

Signature

[Signature]